The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ADAM S. WYSZYNSKI

Appeal No. 2001-1790
Application No. 08/579,072

HEARD: September 9, 2003

Before KRASS, MARTIN and JERRY SMITH, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

ON REQUEST FOR REHEARING

Appellant requests that we reconsider our decision of September 22, 2003, wherein we affirmed-in-part the examiner's decision to reject claims 1-21 under 35 U.S.C. §103. Presumably, appellant has no problem with the part of our decision wherein we reversed the examiner's rejection of claims 6, 12, 14 and 19.

The examiner's rejections are based on the combination of the Yamamoto and Umezawa references and on the combination of the Yamamoto and Kaschke references. We noted in our decision that while appellant's representative argued, during a telephonic hearing, that Yamamoto would be unable to process video signals (and which, if true, would offer substantial evidence tending towards the unobviousness of applying a video signal to the circuit of Yamamoto), the argument did not appear in the briefs and the examiner never had an opportunity to respond to such argument. Accordingly, we refused to consider this argument so late in the prosecution of the instant case.

It is appellant's position that this Board posed the question, during the telephonic hearing, regarding the patentability of claims 1 and 7 in light of the recited video signal processing aspect of the claims as to why the artisan would not have applied a video signal to antenna 11 of Yamamoto. Appellant urges that this characterization of the applied art provides a modification to the Yamamoto circuit resulting in video signal processing being performed instead of the audio processing disclosed in Yamamoto and that this is contrary to the examiner's modification wherein a user receives voice

signals and video signals. As such, appellant contends that we have essentially issued a new ground of rejection and that appellant should be given an opportunity to respond to such rejection.

We have reconsidered our decision in view of appellant's comments and we grant appellant's request by designating our affirmance of the rejection of claims 1-5, 7-11, 13, 15-18, 20 and 21 as a new ground of rejection under 37 C.F.R. 1.196.

The request is granted under 37 CFR §1.197(b) and the case is remanded to the examiner with respect to the patentability of claims 1 and 7 and the claims dependent therefrom. Should the examiner continue to be of the opinion that claims 1-5, 7-11, 13, 15-18, 20 and 21 should be rejected under 35 U.S.C. §103 over the applied references, the examiner is hereby ordered to provide specific reasoning to support that position, specifically responding to appellant's argument regarding Yamamoto's inability to process video signals. If the examiner decides to pursue the matter, the examiner must provide a rationale, specifically addressing each of appellant's points, as to why appellant's position, set forth at pages 3-4 of the request for rehearing of November 21, 2003, is in error.

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This application by virtue of its "Special" status, requires an immediate action, Manual of Patent Examining Procedures (MPEP) Section 708.01(7th ed., July 1998). It is important that the Board be informed promptly of any action affecting the appeal in this case.

GRANTED
and
REMANDED

ERROL A. KRASS
Administrative Patent Judge

JOHN C. MARTIN
Administrative Patent Judge

JERRY SMITH
Administrative Patent Judge

) BOARD OF PATENT APPEALS AND INTERFERENCES

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